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David M. Berezowski

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ROPES & GRAY LLP

PATENT DOCKETING 39/361

1211 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-8704

EXAMINER

SHANG, ANNAN Q

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: DAVID M. BEREZOWSKI and MICHAEL D. ELLIS

Application No. 09/823,705
Technology Center 2400

Mailed: April 14, 2009

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 24, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF: GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief, filed August 8, 2008, under the heading “Grounds of rejection to be Reviewed on Appeal”, is unclear and is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office Action of record, including any Advisory Action responsive to any after-final submissions. Each ground of rejection to be reviewed on appeal must be correctly identified.

A review of the last Office Action, the Final Rejection mailed March 22, 2007, finds that claims 1-6, 9-11, 13-46, 50-56, 60-85, 88-90, 92-135, 139-164, 167-169, 171-204, 208-214, 218-237 are rejected under 35 U.S.C. § 102(e) as being anticipated by Maissel et al. (U.S. Patent 6,637,029) and that claims 8, 58, 87, 137, 166 and 216 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maissel et al. and in view of Hendricks et al. (U.S. Patent 6,539,548); whereas Appellants did not address the latter ground of rejection of claims 8, 58, 87, 137, 166 and 216 under 103(a) in view of Hendricks at all in either the Appeal Brief or in the Reply Brief.

Correction of the grounds of rejection to be reviewed on appeal for all claims is required.

APPEAL BRIEF: ARGUMENTS

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed August 8, 2008, under the heading “Argument”, have not been clearly provided in

accordance with 37 C.F.R. § 41.37(c)(1)(vii), as a result of the defective “Grounds of Rejection to be Reviewed on Appeal” stated above.

Appellants have not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

Correction of the arguments is therefore required.

CONCLUSION

Accordingly, it is ORDERED that the application be returned to the Examiner to:

- (1) hold the Appeal Brief filed on August 8, 2008 defective;
- (2) notify Appellants to file a paper properly addressing the grounds of rejection of all claims;
- (3) notify Appellants to file a paper properly presenting the arguments for each grounds of rejection, as required; and
- (4) finally, for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/BIM

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